REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 8, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I.   Claim Rejections - 35 U.S.C. § 101

Claims 1-14, 16-20, 22-33, and 35-43 have been rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. In particular, the Office Action states that Applicant's claims "do not produce any useful result".

Applicant disagrees with the above conclusion given that, for various reasons cited in Applicant's specification, "correlation" of pre-print and post-print information is useful. For example, correlation of such information consolidates the location of information about a given print job, reduces system resources and network traffic, and allows greater control over the selection of the captured information. *See Applicant's specification*, page 2, lines 15-20.

Irrespective of the above, Applicant has amended the independent claims to indicate that the correlated information is stored for later reference. Clearly, such storage of the correlated information and later reference to that information is a "useful result" that satisfies 35 U.S.C. § 101. Applicant therefore requests that the rejections be withdrawn.

II.   Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 7 and 8 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Specifically, the Examiner treats claims 7 and 8 as if they were not amended to recite a "unique job identifier". Given that Applicant submitted those amendments in the previous Response of October 21, 2005. and given that prosecution of the instant application has been reopened by the Examiner, Applicant presumes that the amendments have been entered. In view of those amendments, claims 7 and 8 are not indefinite. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A.   Rejection of Claim 27

Claim 27 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Admitted Prior Art* ("AAPA") in view of *Kujirai, et al.* ("Kujirai," U.S. Pat. No. 6,618,566). Applicant respectfully traverses this rejection.

1.   The Kujirai Disclosure

Kujirai discloses a print control apparatus for generating accounting information relating to a print job. *Kujirai*, Patent Title. As is described in the reference, the Kujirai system includes a "job accounting client application" that monitors a system spooler and acquires information relevant to accounting, such as the number of sheets discharged by a printer to print the user's print job. *Kujirai*, column 5, lines 34-39. Later in the disclosure, Kujirai states that "information" is transferred from the user's printer driver to the job accounting client application 205, and that the information includes a "job identifier 402." *Kujirai*, column 7, lines 30-51.

2.   Applicant's Claim 27

Independent claim 27 provides as follows (emphasis added):

27.   A *port monitor that operates on a peripheral server*, comprising:

a job information collection module configured to *assign unique job identifiers to print jobs*, collect and correlate pre-print and post-print information, the pre-print information being obtained from a host operating system and the post-print information being obtained from a peripheral device that is configured to print jobs, and to store the correlated pre-print information and post print information for later reference.

In the Office Action, the Examiner argues that Applicant admits that obtaining pre-print information, obtaining post-print information, and correlating the pre-print and post-print information is known, but that Applicant does not admit that correlating the pre-print and post-print information using a unique job identifier is known. For that missing teaching, the Examiner relies upon the Kujirai reference. The Examiner argues that Kujirai teaches "associating a job identifier with a print job when spooling the print job."

Applicant notes that, even if all of the above are presumed to be true, the combination of Applicant's alleged admissions and the Kujirai reference would *still* not support a proper case of obviousness under 35 U.S.C. § 103. Applicant describes the reasons for this conclusion in the following.

As a first matter, there is no proper motivation to combine the teachings of Kujirai with a process of collecting pre-print and post-print information. As is noted above, the Kujirai reference pertains to an accounting systems, i.e., a system that tracks use of a resource for purposes of charging the user for that use. The alleged Applicant admissions say nothing about accounting.

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As a second matter, it is clear that the suggestion or motivation to combine the concept of Kujirai's identifier with Applicant's alleged prior art comes from *Applicant's own disclosure.* In other words, there is nothing in the prior art, or in Applicant's Background section, that would suggest to or motivate a person having ordinary skill in the art to use Kujirai's job identifier to correlate pre-print and post-print information. It is Applicant's *own disclosure,* which is not admitted as prior art, that actually provides the missing teaching. Without that teaching, a person having ordinary skill would simply not arrive at the claimed invention. As is well established in the law, such hindsight to the Applicant's own disclosure or claims is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.,* 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention).

As a third matter, Applicant notes that Applicant's claim 27 is explicitly directed to a "port monitor" that operates on a peripheral server. Applicant notes that the Examiner has ignored that explicit limitation in rejecting claim 27. Moreover, Applicant notes that the limitation "port monitor" cannot be disregarded simply because it appears in the claim preamble given that the term "port monitor" actually describes the item that is being claimed and does not merely recite an intended use of the invention. *See* MPEP § 211.

In view of the above, Applicant submits that claim 27 is allowable over the cited prior art sources. Therefore, Applicant requests that the rejection be withdrawn.

B.   Rejection of Claims 1-14, 16-20, 22-26, 28-33, and 35-43

Claims 1-14, 16-20, 22-26, 28-33, and 35-43 have been rejected under 35 U.S.C. § 103(a)

as being unpatentable over *AAPA* and *Kujirai* as applied to claim 27, in view of *Kassan, et al.*

("Kassan," U.S. Pub. No. 2002/0161717). Applicant respectfully traverses this rejection.

1.   The Kujirai Disclosure

Applicant refers to the discussion of the Kujirai reference provided in the foregoing and

incorporates that discussion herein.

2.   The Kassan Disclosure

Kassan discloses a method and system for correlating job accounting information with

software license information. *Kassan*, Patent Title. More specifically, *Kassan* discloses a system

that collects and maintains cost and usage data relative to a resource (e.g., system connect time) for

purposes of charging users for use of the resource. *Kassan*, column 1, paragraphs 0002-0005. At

one point in the disclosure, Kassan states the following: "In yet another embodiment (G), the user-

id is used to correlate license dialogs with job processing information." *Kassan*, paragraph 0173.

3.   Discussion of the Merits of the Rejection

(a)   Claims 1-14 and 38-43

Independent claim 1 provides as follows (emphasis added):

1.   A computer-implemented method, comprising:

associating a print job with a unique job identifier prior to sending the

job to a printing device;

obtaining pre-print information about the print job;

obtaining post-print information about the print job; and

correlating the pre-print information and the post-print information
using the unique job identifier; and

storing the correlated pre-print information and post print information for
later reference.

As is indicated in claim 1, recited are associating a print job with a "unique job identifier",

"obtaining pre-print information", "obtaining post-print information", and the "correlating the pre-

print information and the post-print information *using the unique job identifier*" (emphasis added).

In the Office Action, the Examiner argues that Applicant admits that obtaining pre-print

information, obtaining post-print information, and correlating the pre-print and post-print

information is known, but that Applicant does not admit that correlating the pre-print and post-print

information using a unique job identifier is known. For that missing teaching, the Examiner relies

upon the Kassan reference. In particular, the Examiner argues that Kassan teaches "correlating

information based on an identifier" and cites page 9, paragraph 173 of the Kassan reference for

support. That paragraph, in whole, only states the following:

In yet another embodiment (G), the user-id is used to correlate license dialogs with
job processing information.

Kassan, paragraph 0173.

Applicant notes that, even if all of the above Examiner arguments are presumed to be true,

the combination of Applicant's alleged admissions, Kujirai, and Kassan would *still* not support a

proper case of obviousness under 35 U.S.C. § 103. Applicant describes the reasons for this

conclusion in the following.

(i) No Motivation to Combine Exists

As a first matter, Applicant submits that there is no proper motivation to combine the teachings of Kujirai and Kassan with the process of collecting pre-print and post-print information. As is noted above, both Kujirai and Kassan pertain to accounting systems, i.e., systems that track use of a resource for purposes of charging the user for that use. The alleged Applicant admissions say nothing about accounting.

(ii) Applicant's Claims Being Considered in a Piecemeal Fashion

As a second matter, it appears clear that Applicant's claims are being considered in a piecemeal fashion. In other words, the Office Action identifies various references, each purportedly teaching a discrete element of Applicant's claims. What is missing, however, is an overall teaching that actually ties the teachings of the references together. As is well established in the law, the Examiner must consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). Accordingly, the Examiner cannot simply piece together multiple references to separately account for each explicit limitation in an effort to manufacture a rejection of Applicant's claims.

When Applicant's claims are considered as a whole, it is clear that the proposed combination does not render Applicant's claims obvious. Even assuming there were an adequate teaching or suggestion to combine the references, such combination would still not result in Applicant's claimed inventions. For example, even though Kujirai mentions a "job identifier" used

for accounting purposes and Kassan teaches a "user-id" that is used to correlate "license dialogs" with "job processing information," the fact remains that these teachings do not render obvious "correlating the pre-print information and the post-print information using the unique job identifier" as is explicitly recited in Applicant's claim 1. *Nothing* in either reference contains the "missing link" that would inspire a person having ordinary skill in the art to make the modifications to the alleged admitted system required to arrive at Applicant's claimed inventions in the manner suggested in the Office Action.

(iii)   The Missing Teaching Comes from Applicant's Disclosure, Not the Prior Art

As a third matter, it is clear that the only teaching of "correlating the pre-print information and the post-print information *using the unique job identifier*" (emphasis added) comes from Applicant's own disclosure. In other words, there is nothing in the prior art, or in Applicant's Background section, that would teach or suggest to a person having ordinary skill in the art to use Kujirai's job identifier to correlate pre-print and post-print information. Furthermore, there is nothing in the art, or in Applicant's Background section, that would suggest to such a person to use Kassan's teaching as to correlating "license dialogs" with "job processing information" to correlate pre-print and post-print information using a job identifier. It is Applicant's *own disclosure*, which is not admitted as prior art, that actually provides the missing teaching. Without that teaching, a person having ordinary skill would simply not arrive at the claimed invention. As is well established in the law, such hindsight to the Applicant's own disclosure or claims is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight

combination of components selectively culled from the prior art to fit the parameters of the claimed invention).

(iv)   Dependent Claims

The claims that depend from claim 1 contain further limitations that are not taught or suggested by the prior art. For example, regarding dependent claim 5, Applicant's so-called admitted prior art does not include a teaching of receiving post-print information through the use of "SNMP Gets". Specifically, page 2, lines 1-4 of Applicant's specification do *not* describe anything about SNMP Gets.

Regarding dependent claim 6, Applicant's so-called admitted prior art does not include a teaching of storing a "unique identifier, the pre-print information and the post-print information". Specifically, page 2, lines 1-4 of Applicant's specification do *not* describe anything about storing any "unique identifier".

Regarding dependent claim 7, the Examiner provides *no support whatsoever* for the alleged obviousness of sending the unique identifier, the pre-print information, and the post-print information "to a job table on a peripheral". Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claims 10 and 11, the Examiner provides *no support whatsoever* for the alleged obviousness of a "time threshold", a "storage level threshold", or a "print job quantity threshold", or of "adjusting a value at which the threshold triggers the transfer of data". Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claims 12 and 13, the Examiner provides *no support whatsoever* for the alleged obviousness of "polling a peripheral to determine if the peripheral has finished with

the print job" or "varying the rate of polling as the peripheral works on the print job". Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

(b)   Claims 16-20

Independent claim 16 provides as follows (emphasis added):

16.   A computer-implemented method of capturing print job information, comprising:
configuring a port monitor with a management server;
associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;
sending the print job to the printer;
obtaining pre-print information about the print job;
obtaining post-print information about the print job;
correlating the pre-print information and the post-print information using the unique job identifier; and
storing the correlated pre-print information and post print information for later reference.

Regarding claim 16, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier. Claim 16 and its dependents are allowable for at least the same reasons as claim 1.

Regarding dependent claim 17, the Examiner provides *no support whatsoever* for the alleged obviousness of "configuring a plurality of port monitors" to have a given threshold.

Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding claims 19 and 20, Applicant refers back to the discussion of claims 12 and 13 provided above.

(c) Claims 22-26

Independent claim 22 provides as follows (emphasis added):

> 22. A computer-implemented method, comprising:
>
> receiving a print job with a port monitor;
>
> *wrapping the print job with a unique job identifier to form a wrapped print job*;
>
> sending the wrapped print job to a printer;
>
> *obtaining pre-print information associated with the print job from an operating system*;
>
> *polling the printer to determine if the print job is done*;
>
> obtaining post-print information from the printer;
>
> correlating the pre-print and post-print information to produce correlated information; and
>
> storing the correlated pre-print information and post print information for later reference.

Regarding claim 22, Applicant refers to the discussion provided above in relation to claim 1 regarding providing a "unique job identifier" to a print job. As a further point, Applicant notes that neither the alleged admitted prior art or cited references teach or suggest "wrapping the print job" with a unique job identifier to form a "wrapped print job". *Applicant notes that the Examiner has ignored that explicit limitation in rejecting claim 22.* Specifically, the Examiner

only refers to the Examiner's discussion of previous clams, which do not include the "wrapping" limitation. Furthermore, the prior art does not teach or suggest obtaining pre-print information "from an operating system". Again, as is noted above, in regard to claim 2, page 1, lines 25-26 of Applicant's specification do *not* describe such an aspect. Moreover, the prior art does not teach or suggest "polling the printer to determine if the print job is done". Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

Regarding dependent claim 23, Applicant refers back to the discussion of claim 13.

Regarding dependent claims 24-26, the Examiner provides *no support whatsoever* for the alleged obviousness of the various "threshold" limitations explicitly recited in claims 24-26.

(d)   Claims 28-30

As is identified above, Applicant's alleged admitted prior art and the Kujirai reference do not render Applicant's claim 27 obvious. In that Kassan does not remedy the deficiencies of the rejection against claim 27, Applicant respectfully submits that claims 28-30 are allowable for at least the same reasons that claim 27 is allowable.

Regarding dependent claim 30, Applicant's so-called admitted prior art does not include a teaching of receiving post-print information through the use of "SNMP Gets". Specifically, page 2, lines 1-4 of Applicant's specification do *not* describe anything about SNMP Gets.

(e)   Claims 31-33

Independent claim 31 provides as follows (emphasis added):

31.   At least one computer-readable media having computer readable instructions thereon, which when executed by a computer, cause the computer to:

receive a print job;

wrap the print job with a unique job identifier to create a wrapped print job;

send the wrapped print job to a printer;

obtain pre-print information from an operating system;

obtain post-print information from the printer;

correlate the pre-print information and the post-print information associated with the unique job identifier; and

store the correlated pre-print information and post print information for later reference.

In regard to claim 31, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier. Claim 31 and its dependents are allowable for at least the same reasons as claim 1.

Regarding dependent claim 32, Applicant refers back to the discussion of "polling" provided above in relation to claim 12.

Regarding dependent claim 33, Applicant refers back to the discussion of varying a rate of polling provided above in relation to claim 13.

(f)   Claim 35

Independent claim 35 provides as follows (emphasis added):

35.   A   computer-readable   medium   having   computer-readable instructions for performing the following:

associating a print job with a unique job identifier prior to sending the job to a printing device;

obtaining pre-print information about the print job;

obtaining post-print information about the print job;

correlating the pre-print information and the post-print information using the unique job identifier; and

storing the correlated pre-print information and post print information for later reference.

Regarding claim 35, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

(g)   Claim 36

Independent claim 36 provides as follows (emphasis added):

36.   A   computer-readable   medium   having   computer-readable instructions for performing the following:

configuring a port monitor with a management server;

associating a print job received by a port monitor with a unique job identifier prior to sending the job to a printer;

sending the print job to the printer;

obtaining pre-print information about the print job;

obtaining post-print information about the print job;

correlating the pre-print information and the post-print information using the unique job identifiers; and

storing the correlated pre-print information and post print information for later reference.

Regarding claim 36, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

(h) Claim 37

Independent claim 37 provides as follows (emphasis added):

37. A computer having a processor capable of reading a computer-readable medium to execute instructions to cause the computer to:

receive a print job;

wrap the print job with a unique job identifier to create a wrapped print job;

send the wrapped print job to a printer;

obtain pre-print information from an operating system;

obtain post-print information from the printer;

correlate the pre-print information and the post-print information associated with the unique job identifier; and

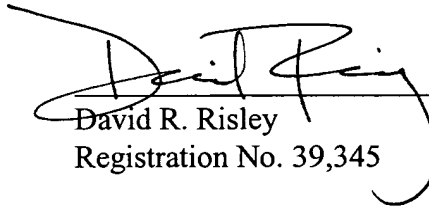store the correlated pre-print information and post print information for later reference.

Regarding claim 37, Applicant refers back to the discussion of claim 1 regarding associating a print job with a unique job identifier and correlating of pre-print and post-print information using the unique job identifier.

As a further point, Applicant notes that neither the alleged admitted prior art or cited references teach or suggest "wrapping the print job" with a unique job identifier to form a "wrapped print job". *Applicant notes that the Examiner has ignored that explicit limitation in rejecting claim 37.* Furthermore, the prior art does not teach or suggest obtaining pre-print information "from an operating system". Again, as is noted above, in regard to claim 2, page 1, lines 25-26 of Applicant's specification do *not* describe such an aspect. Moreover, the prior art does not teach or suggest "polling the printer to determine if the print job is done". Instead, the Examiner simply concludes, without any basis, that such an action would have been obvious.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

7-24-06

Signature

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